Paper No. 9
RFC

9/26/00

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re A. Croteau Lte'e

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Serial No. 75/410,279

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Jess M. Collen of Collen Law Associates for A. Croteau Lte'e.

Sue Carruthers, Trademark Examining Attorney, Law Office 108 (David Shallant, Managing Attorney).

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Before Simms, Cissel and Quinn, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On December 23, 1997, applicant, a Canadian corporation, applied to register the mark "AUSTRALIAN KINGDOM" on the Principal Register for what were subsequently identified by amendment as "clothing for men, women and children, namely hats, bonnets, shawls, scarves, face protector toques, t-shirts, sweatshirts, blouses, shirts, short-sleeved t-shirts, overalls, jumpsuits, aprons, vests, jackets, nightshirts, neckties, wind

resistant jackets, raincoats, gloves, mittens, toques, track suits, jogging suits, one(1)-, two(2) and three(3)-piece dresses, sweaters, tank tops, long pants, short pants, Bermuda shorts, boxing shorts, slips, skirts, divided skirts, socks, stockings, pantyhose, tunics, pullovers, cardigans, jerseys, belts, suspenders, jeans, pyjamas, evening gowns, bathrobes, sleepwear, bras, undergarments, body suits, camisoles, boleros, swimsuits, [and] espadrilles," in Class 25. The application was based on applicant's assertion that it possessed a bona fide intention to use the mark in commerce in connection with these goods.

The Examining Attorney refused registration under Section 2(e)(3) of the Lanham Act, 15 U.S.C. Section 1052(e)(3), on the ground that the mark applicant seeks to register is primarily geographically deceptively misdescriptive in connection with the clothing items which applicant specifies in the application.

When the refusal was made final, applicant timely filed a notice of appeal. Both applicant and the Examining Attorney filed briefs. Attached to the Examining

Attorney's brief were copies of dictionary definitions[1] of "Australia" and "Australian" which establish that Australia is a country and a continent and that textiles are produced there. Applicant did not request an oral hearing before the Board.

Based on careful consideration of the written record and arguments before us, we hold that the refusal to register is well taken because the mark sought to be registered is primarily geographically deceptively misdescriptive of the goods specified in the application.

Applicant does not dispute the accuracy of the Examining Attorney's recitation of the test for registrability under Section 2(e)(3) of the Lanham Act. A mark is unregistrable under this section if its primary significance is geographic; if purchasers would be likely to assume that the goods come from that place, i.e., that purchasers would make a goods/place association; and if the goods do not, in fact, come from the place that the mark names. In re Nantucket, Inc., 677 F.2d 95, 213 USPQ 889 (CCPA 1982).

[1] While this evidence would otherwise be considered untimely, the Board may take judicial notice of dictionary definitions at any juncture.

In the instant case, each of the three elements of this test have been met. The Examining Attorney has made a prima facie showing that the mark applicant intends to use is primarily geographically deceptively misdescriptive because she has shown that the primary significance of the mark is geographic and that purchasers of the goods specified in the application would make an association between the place named in the mark and the goods. Also, applicant concedes that its products will come from Canada, and not from Australia.

Applicant argues that the mark it seeks to register is a unitary mark which, when it is considered in its entirety, has significance that is not primarily geographic. Applicant further argues that even if the primary significance of the mark had been established to be geographic, the Examining Attorney has failed to demonstrate that a goods/place association would be made by purchasers of the clothing items listed in the application. Neither of these arguments is persuasive.

TMEP Section 1213.06(a) defines a unitary mark as a mark wherein the elements of the mark are so merged together that they cannot be divided into separable elements. In the case at hand, applicant contends that the word "Australia" connotes "a far away place, the land down

under, an exotic location," while the word "kingdom" implies royalty, the state government, or a realm or province and nature." As the Examining Attorney points out, by reciting these meanings of the component words in the mark it seeks to register, applicant has itself provided support for the conclusion that the primary significance of "AUSTRALIAN KINGDOM" is geographic. Australia is indeed the place applicant concedes that it is. By adding the word "KINGDOM," applicant has merely reinforced the notion of a country or political unit. The overall connotation of the term sought to the registered is primarily geographic, a reference to the country of Australia.

Moreover, even if the combined term were unitary, it would still be unregistrable under the Lanham Act. Just as "AMERICAN BEAUTY" was found to be primarily geographically deceptively misdescriptive in connection with sewing machines made in Japan in Singer Manufacturing Co. v. Birginal-Bigsley Corp., 138 USPQ 63 (CCPA 1963), and "NEW YORK WAYS GALLERY" was held to be primarily geographically deceptively misdescriptive of various types of bags not made in New York in In re Wada, 194 F.2d 1297, 52 USPQ2d 1539, (Fed. Cir. 1999), aff'g 48 USPQ2d 1689 (TTAB 1998).

the primary significance OF "AUSTRALIAN KINGDOM" is geographic.

With regard to applicant's argument that the Examining Attorney has not established that a goods/place association would be made by purchasers of the clothing items listed in the application, we note that she was not obligated to introduce evidence that Australia is noted for any of the clothing items listed in the application in order to establish that association would be made between Australia and such clothing products. In re Nantucket, Inc., supra. As pointed out in the concurring opinion in that case, a goods/place association can be established when the place named in the mark is not necessarily known for or noted for the particular products specified in an application for trademark registration. As Judge Nies stated in that case, a prima facie goods/place association could be made between "Chicago" and almost any product, "…and an applicant would have a difficult task to overcome it." We agree with the Examining Attorney that if a goods/place association can be assumed in connection with the name of a large American city irrespective of the nature of the goods involved, then we may find that a goods/place association would be made when the mark is the name of an entire country and the

goods in question are clothing items which are produced worldwide.

In summary, the primary significance of the mark sought to the registered is geographic; a goods/place association would be made between the goods specified in the application and place named in the mark; and the goods will, in fact, not originate in the place named in the mark. Accordingly, the refusal to register under Section 2(e)(3) of the Lanham Act must be affirmed.

R. L. Simms

R. F. Cissel

T. J. Quinn
Administrative Trademark Judges
Trademark Trial & Appeal Board